# UNITED STATES PATENT AND TRADEMARK OFFICE

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| 10/014,202 | 11/13/2001 | Srinivas Gutta | US010572 | 2934 |

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| EXAMINER |
|---|
| LASTRA, DANIEL |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on _13 March 2009_.

2a)☐ This action is **FINAL**.  2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) _1,3-9,11-20,22 and 23_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1,3-9,11-20,22 and 23_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

1.     Claims 1, 3-9, 11-20, 22 and 23 have been examined. Application 10/014,202

(METHOD AND APPARATUS FOR RECOMMENDING ITEMS OF INTEREST BASED

ON PREFERENCES OF A SELECTED THIRD PARTY) has a filing date 11/13/2001.

### Response to Amendment

2.     In response to BPAI Decision filed 01/15/2009, the Applicant filed an Amendment

on 03/13/2009, which amended claims 1, 3, 7, 14, 17, and cancel claims 10 and 21.

### *Claim Rejections - 35 USC § 101*

3.     35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-9 and 11-13 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.   Based on Supreme Court

precedent, a method/process claim must (1) be tied to a particular machine or

apparatus (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook,

437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane

v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transforms a particular article to a

different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A

method/process claim that fails to meet one of the above requirements is not in

compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject

matter. Here the claims fail to meet the above requirements because the steps are

neither tied to a particular machine or apparatus nor transforms a particular article to a

different state or thing. The Applicant needs to add significant structure to the claims.

### *Claim Rejections - 35 USC § 102*

4.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-9 and 11-23 are rejected under 35 U.S.C. 102(b) as being

anticipated by Herz (US 5,758,257).

As per claims 1, 14, 17, 22 and 23, Herz teaches:

A computerized method for recommending one or more available items to a

target user, comprising the steps of:

obtaining a history of selecting one or more available items by at least one third

party (see column 5, lines 24-54);

partitioning a third party selection history into a plurality of clusters (see column

5, lines 24-54).  According to Applicant's specification (see Applicant's specification

page 7, lines 16-20), a partition is equivalent to a cluster. Herz teaches clustering (i.e.

partitioning) the profiles of third party persons viewing history (see col 38, lines 1-55)

and combining the viewing profiles of two or more customers, with equal or unequal

weightings, so that the video programming with content profiles strictly within the

overlap area of the combined customer profiles will be preferred" (see col 39, lines 50-

55)

wherein each cluster comprises a segment of tangible items that exhibit a characteristic similarity (see Herz column 34, lines 57-60; column 38, lines 10-15;), wherein each cluster contains items that are closer to the mean of the cluster than any other cluster from among the plurality of clusters (see column 12, lines 29-55; column 37, lines 34-60; column 38, lines 1-55),

modifying a target user's history of selecting said one or more available items with one or more third party clusters to produce a modified target user's history (see column 39, lines 45-55). Herz creates an agreement matrix that is based upon customer's viewing history where for example, in col 39, lines 50-55, the modified viewer history of customer 2 is based upon the viewing history of customer 1.

processing the modified target user's history to generate a target user profile, wherein the modified target user's history characterizes preferences of the target user as modified to reflect preferences of the third party (see column 40, lines 35-65). Herz uses the created modified customer's viewing history (see col 39, lines 50-55) in order to suggest programming for "virtual channels" to select the most desired programming for the customers (i.e. generating a customer's preference) (see col 40, lines 55-65).

generating a recommendation score for at least one of said available items (see column 5, lines 5-20) based on said target user's profile (see column 49, lines 1-20); and

displaying the recommendation score to the target user on a display (see column 49, lines 1-20).

As per claims 3 and 16, Herz teaches:

wherein said obtaining step further comprises the step of receiving a user selection of one or more of said clusters of similar items (see column 5, lines 24-54).

As per claim 4, Herz teaches:

wherein said one or more items are programs (see column 5, lines 1-20).

As per claim 5, Herz teaches:

wherein said one or more items are content (see column 8, lines 20-25).

As per claim 6, Herz teaches:

wherein said one or more items are products (see column 47, lines 53-67).

As per claims 7 and 18, Herz teaches:

A computerized method for maintaining a user profile indicating preferences of a user, comprising the steps of:

partitioning a third party selection history into a plurality of clusters *by a data processor*, wherein each cluster comprises a segment of tangible items that exhibit a characteristic similarity (see column 34, lines 57-60; column 38, lines 10-15), wherein each cluster contains items that are closer to the mean of the cluster than any other cluster from among the plurality of clusters (see column 12, lines 29-55; column 38, lines 1-55);

receiving a selection from said user of at least one of said clusters of similar items (see column 5, lines 24-54;); and

modifying or updating said user profile using said user selected clusters by said data processor (see column 6, lines 50-55; column 30, lines 10-25).

wherein said step of updating said user profile further comprises the steps of updating a selection history of said user with items from said selected clusters and updating said user profile using said updated selection history (see column 39, lines 45-55). Herz creates an agreement matrix that is based upon customer's viewing history where for example, in col 39, lines 50-55, the modified viewer history of customer 2 is based upon the viewing history of customer 1.

As per claims 8 and 19, Herz teaches:

wherein said user profile is associated with a program content recommender (see column 4, lines 32-57).

As per claims 9 and 20, Herz teaches:

wherein said user profile indicates viewing preferences of said user (see column 4, lines 40-47).

As per claim 11, Herz teaches:

wherein said one or more items are programs (see column 5, lines 1-21).

As per claim 12, Herz teaches:

wherein said one or more items are content (see column 8, lines 12-22).

As per claim 13, Herz teaches:

wherein said one or more items are products (see column 47, lines 52-67).

As per claim 15, Herz teaches:

wherein said processor is further configured to partition said third party selection history into clusters containing similar items (see column 5, lines 24-54).

## *Response to Arguments*

5.      The Board of Appeal decision filed 01/15/2009 found that <u>Herz</u> did not teach modifying a target's user history of selecting said one or more available items with one or more third party cluster to produce a modified target user's history; processing the modified target user's history to generate a target user profile, wherein the modified target user's history characterizes preferences of the target user as modified to reflect preferences of the third party" because according to the Board, the cited col 49, lines 1-20 do not suffice to meet these limitations and that if the "viewing history" (col 39, lines 24-37) of <u>Herz</u> is employed to meet the "history" limitation of the claim, it is that same "viewing history" of <u>Herz</u> that must be modified to meet the limitation of "modifying a target user's history". The Examiner answers that <u>Herz</u> creates an agreement matrix that is based upon customer's viewing history where for example, in col 39, lines 50-55, the modified viewer history of customer 2 is based upon the viewing history of customer 1 and <u>Herz</u> uses the created modified customer's viewing history (see col 39, lines 50-55) in order to suggest programming for "virtual channels" to select the most desired programming for the customers (i.e. generating a customer's preference) (see col 40, lines 55-65). Therefore, the Examiner is using the same "viewing history" cited in col 39, lines 24-37) to create a modified viewer history, which is shown in col 39, lines 50-55) and therefore, <u>Herz</u> teaches Applicant's claimed invention.

### *Conclusion*

6.      Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Examiner, Art Unit 3688
April 24, 2009